

## REMARKS

Claims 23-44, as amended, are presented in this application. Claims 23, 30 and 34 are in independent form. Claims 23, 24, 30, 32-35, 41, 43 and 44 have been withdrawn. Claims 1-22 have been previously cancelled. Claims 23, 30 and 34 have been amended to further define the invention. The claim amendments do not introduce new matter so that they should be entered at this time to reduce the issues for appeal. As these changes further define the invention that was previously discussed and presented, it is believed that these amendments do not raise new issues that require a further search. For the reasons that follow, it is respectfully submitted that these changes at least overcome some of the rejections, thus reducing the issues for appeal. It is further submitted that all rejections are overcome and that these changes now place the entire application in condition for allowance.

## Election/Restriction

Claims 25-29 and 31 were previously restricted, and the Examiner withdrew claims 36-40 and 42 because those claims have the same recitations as previously presented claims 25-29 and 31. Applicant acknowledges this withdrawal but understands that upon allowance of a generic claim, all these claims will be rejoined, reconsidered and allowed.

## Rejection under 35 U.S.C. § 102(e)

Claims 23, 24, 34 and 35 were rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,653,205 to Yanagita et al. ("the Yanagita '205 patent").

The Yanagita '205 patent describes a method and apparatus for separating a composite member, where the composite member has an upper and lower face which are positioned between an elastic body and a support portion (see the Yanagita '205 patent, col. 10, lines 56-67). The present application is different from the Yanagita '205 patent in that the substrate is held between two structures which engage the side surface/sidewall of the substrate (see Paragraph [0043], Figure 2a). As previously noted, no support structure contacts the upper and lower face/surface of the substrate.

Applicants have amended claims 23 and 34 to more clearly define the invention. Claim 23 now recites "providing a semiconductor substrate having a weakened area, an upper face, a lower face, a sidewall [and] . . . the semiconductor substrate being held between the

positioning member and the at least one blade and being unsupported at the upper and lower faces . . . ." Claim 34 now recites "providing a semiconductor substrate with a first face, a second face . . . wherein the substrate is held in position between the positioning member and the blade without any support contacting the first and second faces." As these changes are supported by the specification as originally filed, there is no issue of new matter.

Applicants respectfully submit that the Yanagita '205 patent does not disclose, teach or suggest all the features of claims 23 and 34. Specifically, there is no disclosure, teaching or suggestion in the Yanagita '205 patent of supporting a substrate between a positioning member and at least one blade without any support contacting the faces of the substrate. As all the features recited in independent claims 23 and 34, as amended, are not disclosed, taught or suggested by the Yanagita '205 patent, Applicants submit that these claims are allowable over the Yanagita '205 patent. Dependent claims 24 and 35 are dependent from independent claims 23 and 34, respectively, and are allowable for at least the same reason as discussed above in connection with claims 23 and 34.

#### **Rejection under 35 U.S.C. § 103(a)**

Claims 23, 24, 32, 34, 35 and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Yanagita '205 patent in view of U.S. Patent No. 6,427,747 to Omi et al. ("the Omi '747 patent").

The Omi '747 patent describes substrate holders which hold the substrate by clamping the substrate from both sides (see the Omi '747 patent, col. 6, lines 51-54). The Omi '747 patent also discloses placing a substrate in a groove in a positioning shaft (see the Omi '747 patent, col. 7, lines 41-45). The present application is different from the Omi '747 patent in that the substrate is held between two structures which engage the side surface/sidewall of the substrate (see Paragraph [0043], Figure 2a). No supports structure contacts the upper and lower face/surface of the substrate.

The Omi '747 patent does not resolve the deficiencies the Yanagita '205 patent. In particular, the Omi '747 patent does not disclose, teach or suggest supporting a substrate between a positioning member and at least one blade without any support contacting the faces of the substrate.

As all the features recited in independent claims 23 and 34, as amended, are not disclosed, taught or suggested by the Yanagita '205 patent or the Omi '747 patent, Applicants submit that these claims are allowable over the Yanagita '205 patent and the Omi '747 patent. Dependent claims 24 and 32 are dependent from independent claim 23 and dependent claims 35 and 43 are dependent from independent claim 34. Claims 24, 32, 35 and 43 are allowable for at least the same reason as discussed above in connection with claims 23 and 34.

Claims 30 and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Yanagita '205 patent in view of the Omi '747 patent and further in view of U.S. Patent No. 6,436,226 to Omi et al. ("the Omi '226 patent").

The Omi '226 patent discloses the same structure as the Omi '747 patent.

Applicants have amended claims 30 and 34 to more clearly define the invention.

Claim 30 now recites "providing a semiconductor substrate having a weakened area, a sidewall and a notch in the sidewall . . . positioning at least a portion of the sidewall of the semiconductor substrate against a fixed positioning member; contacting at least one blade with the notch of the semiconductor substrate . . . and moving at least a portion of the support away from the substrate as the blade contacts the notch so that the positioning member and blade are the only structures supporting the substrate. Claim 41, which incorporates the amendments of claim 34, now recites "providing a semiconductor substrate with a first face, a second face . . . wherein the substrate is held in position between the positioning member and the blade without any support contacting the first and second faces." As these changes are supported by the specification as originally filed, there is no issue of new matter.

The Omi '226 patent does not resolve the deficiencies of the Yanagita '205 patent or the Omi '747 patent. In particular, the Omi '226 patent does not disclose, teach or suggest supporting a substrate along only a sidewall of the substrate.

Applicants respectfully submit that neither the Yanagita '205 patent, the Omi '747 patent nor the Omi '226 patent discloses, teaches or suggests all the features of claims 30 and 41. Specifically, there is no disclosure, teaching or suggestion in the Yanagita '205 patent, the Omi '747 patent or the Omi '226 patent of supporting a substrate between a positioning member and at least one blade without supporting first and second faces. As all the features recited in independent claim 30 and dependent claim 41, as amended, are not disclosed, taught or suggested by the Yanagita '205 patent, the Omi '747 patent or the Omi '226 patent, Applicants

submit that these claims are allowable over the Yanagita '205 patent, the Omi '747 patent and the Omi '226 patent.

Claims 33 and 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Yanagita '205 patent in view of the Omi '747 patent and further in view of U.S. Patent Nos. 6,979,629 to Yanagita et al. ("the Yanagita '629 patent"), 6,263,941 to Bryan et al. ("Bryan") and 6,415,843 to De et al. ("De").

Neither the Yanagita '629 patent, Bryan nor De resolve the deficiencies of the Yanagita '205 patent or the Omi '747 patent. In particular, Yanagita '629 patent, Bryan nor De do not disclose, teach or suggest supporting a substrate between a positioning member and at least one blade without any support contacting the faces of the substrate.

Claims 33 and 44 are dependent from independent claims 23 and 34, respectively, and are allowable for at least the same reason as discussed above in connection with claims 23 and 34.

In light of Applicants' amendments and remarks, a notice of allowance is respectfully requested. Should the Examiner have any questions or concerns regarding the amendments, remarks or the above-identified application, then a telephonic interview with the undersigned is respectfully requested to discuss any such questions or concerns and to accelerate the allowance of the above-identified application.

Respectfully submitted,

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